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at least one colorant; and silica, wherein when the composition is combined with water, the amount of the colorant and the silica is effective to provide a color change in the composition when the composition dries.

### **REMARKS/ARGUMENTS**

#### **I. Status of the Claims**

Claims 1-13 are pending. Claim 1 has been amended to more clearly define that which Applicants' consider to be their invention. Support for the amendment to claim 1 can be found in the Specification, at least at page 3, lines 7-10 and lines 20-21. Accordingly, no new matter has been introduced by this Amendment.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page(s) is/are captioned "Version with markings to show changes made".

#### **II. Claim Rejections – 35 U.S.C. § 112**

The Examiner has rejected claim 1 as indefinite in that it is unclear whether the language is drawn to a process of making, or a structural limitation of the claimed composition. Applicants have amended claim 1 so that it is clear that the amount of the colorant and the silica in the composition is effective to provide a color change in the composition when the composition dries.

#### **III. Claim Rejections - 35 U.S.C. § 103**

##### **A. The Rejection of Claims 1-10, 12 and 13 Over Neova In View of Gerstein**

The Examiner has rejected claims 1-10, 12 and 13 as unpatentable over Neova in view of U.S. Patent No. 5,139,771 ("Gerstein"). The Examiner relies upon Neova product label as disclosing a silica-containing skin mask composition. Recognizing that Neova fails to teach the incorporation of a colorant or the quantity of surfactants used, the Examiner relies upon Gerstein. For the reasons discussed below, Gerstein fails to remedy the deficiencies of Neova.

As discussed in the Specification, it is sometimes difficult to determine when it is time to remove a dry facial mask. The mask should be left on long enough to provide the cleansing, exfoliating, and moisturizing properties it is meant to deliver. Facial mask formulations are typically prepared such that the proper leave on time for the desired benefits is equal to the drying time of the formulation. Therefore, typical facial masks should be removed when the formulation has completely dried. However, with many facial mask formulations, it is difficult to tell when the formulation has completely dried. Therefore, there is a need for a facial mask that provides a change in appearance that indicates it is dry. The present invention answers this need.

Claim 1 relates to a composition for forming a cosmetic mask comprising at least one colorant and silica, wherein when the composition is combined with water, the amount of the colorant and the silica is effective to provide a color change in the composition when the composition dries. Such a facial mask is neither taught nor suggested by the combination of Neova and Gerstein.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. § 2143. Here, there is nothing in the teachings of Neova and Gerstein that would provide one of ordinary skill in the art with the suggestion or motivation to incorporate a colorant into the Neova compositions in order to obtain a facial mask composition that changes color when the composition is dry. The Examiner recognizes that the combined references "do not explicitly provide that the color changes as the composition dries." Nevertheless, the Examiner takes the position that "the color change is an inherent property of the prior art composition which otherwise meets the limitation of the instant claims." Applicants respectfully traverse.

The Examiner has not provided any rational or evidence which tends to show inherency. See M.P.E.P. § 2112, p. 2100-51. The fact that a certain result or characteristic

may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *Id.*

There is nothing in the Neova product label that would suggest to one of ordinary skill in the art that silica could be used in combination with a colorant to provide an indication that the composition has dried via a color change in the composition. In fact, as recognized by the Examiner the Neova product label does not even mention the use of colorants. Further, Gerstein simply teaches that colorants can be added to “impart a pleasant color to the face masque composition.” See col. 5, lines 28-32. Accordingly, Gerstein fails to remedy the deficiencies of the Neova product label.

Even if one of ordinary skill in the art were motivated to incorporate a colorant into the composition disclosed by the Neova product label, a cosmetic mask composition comprising at least one colorant and silica, wherein when the composition is combined with water, the amount of the colorant and the silica is effective to provide a color change in the composition when the composition dries would not necessarily result since neither Neova nor Gerstein teach or suggest a facial mask composition that changes color upon drying. As discussed in the M.P.E.P., the mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency of that result. Accordingly, Applicants respectfully submit that applicants claimed invention is not inherent in the combination of the Neova product label and Gerstein and the rejection should be withdrawn.

**B. The Rejection of Claim 11 Over Neova In View of Gerstein and Further In View of Cabot Technical Data**

The Examiner has rejected claim 11 as unpatentable over Neova in view of Gerstein and further in view of Cabot Technical Data. Applicants respectfully traverse this rejection since, for the reasons discussed above, the combination of Neova and Gerstein fails to render obvious a composition for forming a cosmetic mask comprising at least one colorant and silica, wherein when the composition is combined with water, the amount of the colorant and the silica is effective to provide a color change in the composition when the composition dries. Clearly Cabot fails to remedy the deficiencies of the Neova product label and Gerstein.

Cabot teaches the inclusion of fumed silica in cosmetic and personal care products. However, there is no teaching or suggestion that fumed silica could be used in combination with a colorant to provide an indication that the composition has dried via a color change in the composition. Accordingly, the combination of Neova, Gerstein and Cabot fails to render claim 11 obvious and the rejection should be withdrawn.

**C. The Rejection of Claims 1-4 and 11-13 Over Jung**

The Examiner has rejected claims 1-4 and 11-13 as being unpatentable in view of U.S. Patent No. 5,139,782 ("Jung"). Applicants respectfully traverse this rejection.

Jung relates to a composition for the cosmetic treatment of human skin to remove retention products from the skin surface and sebaceous follicles. The composition comprises a high-silica zeolite. Jung teaches that "while colorants may be aesthetically desirable, in certain instances, the normal off-white color of the composition in the absence of added colorants is entirely acceptable as is." See col. 5, lines 30-34. There is no teaching or suggestion that a high-silica zeolite could be used in combination with a colorant to provide an indication that the composition has dried via a color change in the composition. The Examiner recognizes that Jung "does not explicitly provide that the color changes as the composition dries" but nevertheless argues that the color change is "an inherent property" of the composition. Applicants respectfully disagree.

As discussed above, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. The Examiner must provide a rational or evidence which tends to show inherency. See M.P.E.P. § 2112, p. 2100-51. Jung teaches that colorants may be added for aesthetic reasons, there is no teaching or suggestion that the high-silica zeolite could be used in combination with a colorant to provide a composition that indicates when it is dried via a color change in the composition. Such a characteristic does not necessarily flow from the teachings of Jung. Accordingly, Jung fails to render Applicants' claimed invention obvious and the rejection should be withdrawn.

**VI. Conclusion**

Applicants believe that the foregoing presents a full and complete response to the outstanding Office Action. An early and favorable response to this Amendment is earnestly solicited. If the Examiner feels that a discussion with Applicants' representative would be helpful in resolving the outstanding issues, the Examiner is invited to contact Applicants' representative at the number provided below.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 10-0750/JBP-563/EMH. If a fee is required for an Extension of time 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

By: \_\_\_\_\_



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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**In the Claims:**

1 (Amended). A composition for forming a cosmetic mask comprising:

at least one colorant; and

silica, wherein when the composition is combined with water, the amount of the colorant and the silica is effective to provide a color change [upon drying] in the composition when the composition dries.